

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT

#25/IDS  
2-13-04  
L. Spruell

Applicant: John J. McKillip

Appln No.: 10/004,510

Filed: November 2, 2001

For: METHOD AND APPARATUS  
FOR PRODUCING  
MULTIPLE DIE-CUT  
BUSINESS FORMS

TC/AU: 2854

Examiner: Eickholt, Eugene H.

Docket No.: 72412

Customer No.: 22242

) Confirmation No.: 6502

) CERTIFICATE OF MAILING

) I hereby certify that this paper (along with any  
) paper referred to as being attached or enclosed) is  
) being deposited with the United States Postal  
) Service with sufficient postage as first class mail in  
) an envelope addressed to the Commissioner for  
) Patents, P.O. Box 1450,  
) Alexandria, VA 22313-1450, on this date.

) 01/06/04  
) Date

Jon A. Birmingham

Registration No. 51,222  
Attorney for Applicant(s)

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

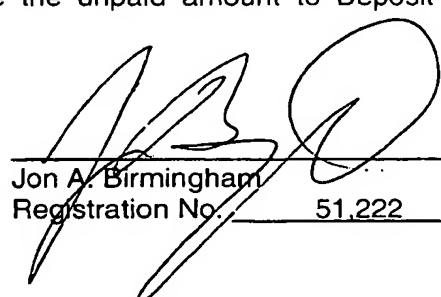
Sir:

Pursuant to the duty of disclosure under 37 CFR § 1.56, and in accordance with 37 CFR §§ 1.97 and 1.98 and MPEP § 2001.06(c) regarding information learned through litigation, Applicant brings the following information with respect to the above-identified application to the attention of the Examiner. This information arose from *Ameriprint Corp. v. Malessa Partners, LLC et al*, civil action no. 02 C 8110, in the Northern District of Illinois involving United States Patent Nos. 6,182,572 ("the '572 patent") and 6,389,971 ("the '971 patent").

2. Additional Items:

- ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. §1.103(c) for a period of \_\_\_\_ months. (*Period of suspension shall not exceed three months; Fee under 37 C.F.R. §1.17(i) required.*)
- ☐ A petition for extension of time is enclosed.
- ☒ A return receipt postcard is enclosed.
- ☐ Other:
  
- ☐ Applicant(s) assert entitlement to Small Entity Status (37 C.F.R. § 1.27).
- ☐ RCE Fee required under 37 C.F.R. § 1.17(e) without a claim of small entity status is: \_\_\_\_\_.
- ☒ RCE Fee required under 37 C.F.R. § 1.17(e) by an entity claiming small entity status is: \$385.00.
- ☐ A check in the amount of \$\_\_\_\_\_ is enclosed.
- ☒ Charge \$ 385.00 to Deposit Account No. 06-1135.
- ☒ The Director is hereby authorized to charge any additional fees which may be required in this application under 37 C.F.R. §§1.16-1.17 during its entire pendency, or credit any overpayment, to Deposit Account No. 06-1135. Should no proper payment be enclosed herewith, the Director is authorized to charge the unpaid amount to Deposit Account No. 06-1135. This sheet is filed in duplicate.

January 6, 2004  
Date

  
\_\_\_\_\_  
Jon A. Birmingham  
Registration No. 51,222

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<u>NON PATENT LITERATURE DOCUMENTS</u>		<u>PAGES</u>
<u>PLEADINGS AND TRANSCRIPTS</u>		
1.	Chicago Tag & Label, Inc.'s Response to Malessa's First Set of Interrogatories, March 31, 2003 (12 pages).	1, 11-21
2.	Chicago Tag & Label, Inc.'s Supplemental Response to Malessa's First Set of Interrogatories including exhibits, June 24, 2003 (13 pages).	1-6, 8-14
3.	Transcript of Patrick J. Quinlan's Deposition, August 27, 2003.	1, 14-52, 63-65
4.	Transcript of James Schulty's Deposition, June 6, 2003.	1, 59-107, 177-181
5.	Transcript of Davis Steidinger's Deposition, June 19, 2003.	1, 32-63, 103-104, 110-119, 181-185
6.	Transcript of Steve Kreuzer's Deposition, September 8, 2003.	1, 9-84, 90
7.	Transcript of David W. Paularena's Deposition, August 29, 2003.	1, 52-54, 75-76, 92

NON PATENT LITERATURE DOCUMENTS

8. Fax from P.J. Quinlan to Dave Paularena dated May 24, 1997 (1 page).
9. Letter to P.J. Quilan from Natasha Stone on Webtron stationery dated February 2, 1998 (1 page) enclosing Machine Order and Contract dated February 2, 1998 (2 pages).
10. Drawing No. DP-1853 entitled "Flexo Press BX 1305" with handwritten markings and dated June 17, 1998 (1 sheet).
11. Letter on Aquaflex stationery to Mr. Quinlan from Daniel Presseault hand dated April 10, 1998 with hand drawing titled "Proposal for 'Preferred Customer Club'" (2 pages).
12. Drawing No. DP-1945-1 entitled "Flexo Press BX 1308(4)" dated July 29, 1998 with photographs attached (3 sheets).
13. Letter on Tamarack stationery from Gayle Harrop to a Jim Schulty dated February 14, 1998 enclosing document entitled "Tamarack Affixing Equipment" dated March 9, 1998 (2 pages).
14. Document entitled Uarco General Requisition No. 36556 dated November 10, 1994 (1 page).

NON PATENT LITERATURE DOCUMENTS

15. Document entitled "Interoffice Memo" from a George Zehner to a Don Sanders and dated March 3, 1995 (1 page).
16. Photograph of Uarco Press 391, as marked by Mr. Kreuzer during his deposition on September 8, 2003 (1 photo).
17. Document entitled "Interoffice Memo" from a Steve Kreuzer to a Van Kleinman dated November 2, 1995 (1 page).

The above documents are listed on Form PTO/SB/08 which accompanies this Information Disclosure Statement. A copy of each reference is enclosed herewith.

The above information relates to allegations of invalidity of the '971 and '572 patents, such as invalidity based on prior offers for sale and prior public use. The lawsuit has been dismissed by the parties. Portions of the transcripts have been redacted pursuant to a Protective Order. The following table identifies the exhibits discussed in the depositions. Each of these exhibits is either submitted herewith or was previously submitted.

DEPOSITION  
EXHIBIT

IDENTIFICATION OF EXHIBIT

Quinlan Dep. Ex. 126.	Fax from P.J. Quinlan to Dave Paularena dated May 24, 1997 (1 page).
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DEPOSITION EXHIBIT	IDENTIFICATION OF EXHIBIT
Quinlan Dep. Ex. 127.	Letter on Aquaflex stationary to a Mr. Quinlan dated June 24, 1997 (2 pages).
Quinlan Dep. Exs. 128 and 129.	Document entitled "Tamarack Affixing Equipment integrated with an Aquaflex press for GenForms" dated August 1, 1997, and letters dated July 02, 1997, July 10, 1997, August 1, 1997 and September 3, 1997 (6 pages).
Quinlan Dep. Ex. 130.	Drawing No. DP-1853 entitled "Flexo Press BX 1305" with handwritten markings and dated June 17, 1998 (1 sheet).
Quinlan Dep. Ex. 131.	Letter on Aquaflex stationery to Mr. Quinlan from Daniel Presseault hand dated April 10, 1998 with hand drawing titled "Proposal for 'Preferred Customer Club'" (2 pages).
Quinlan Dep. Ex. 132.	Document entitled "GenForms Purchase Order" and dated February 4, 1998 (1 page).
Schulty Dep. Ex. 65.	Drawing No. DP-1945-1 entitled "Flexo Press BX 1308(4)" dated July 29, 1998 with photographs attached (3 sheets).

DEPOSITION EXHIBIT	IDENTIFICATION OF EXHIBIT
Schulty Dep. Ex. 67 (several documents included).	Letter on Tamarack stationery from a Gayle Harrop to a Jim Schulty dated March 10, 1998 (1 page) enclosing document entitled "Tamarack Affixing Equipment" dated March 9, 1998 (2 pages).
Schulty Dep. Ex. 67.	Letter on Tamarack stationery from Gayle Harrop to a Jim Schulty dated February 14, 1998 enclosing document entitled "Tamarack Affixing Equipment" dated March 9, 1998 (2 pages).
Schulty Dep. Ex. 68.	Letter on Tamarack stationery from a Gayle Harrop to a Jim Schulty dated March 10, 1998 (1 page) enclosing document entitled "Tamarack Affixing Equipment" dated March 9, 1998 (2 pages).
Schulty Dep. Ex. 69.	Letter on Tamarack stationery from a Gayle Harrop to a Jim Schulty dated February 6, 1998 (2 pages) enclosing document entitled "Tamarack Finishing Equipment" dated February 6, 1998 (4 pages).
Steidinger Dep. Ex. 19 (several documents included).	Drawing No. 930928, entitled "Tamarack Label Application In-Line Installation With Hamilton 28"D. Roll 20" Web Collator for General Business Forms" and dated September 27, 1993 (1 sheet).

DEPOSITION EXHIBIT	IDENTIFICATION OF EXHIBIT
Steidinger Dep. Ex. 19.	Document entitled "General Business Forms" and dated October 29, 1993 (3 pages).
Steidinger Dep. Ex. 19.	Document entitled "Tamarack Products Inc. Invoice No. 940921" and dated September 21, 1994 (3 pages).
Steidinger Dep. Ex. 20.	Drawing No. 921014, entitled "Hamilton Jumbo/Stencil-Label Applicator" and dated October 14, 1992 (1 sheet).
Steidinger Dep. Ex. 21.	Tamarack Brochure having a footer reading "Print '97 McCormick Place, Chicago" (2 pages).
Steidinger Dep. Ex. 92.	Document entitled "Bielomatik - Web-Finishing Machine" (pp. A656-667).
Steidinger Dep. Ex. 98.	Photograph of Uarco Press 391 no date known (1 photo).
Kreuzer Dep. Ex. 58.	Document entitled Uarco General Requisition No. 36556 dated November 10, 1994 (1 page).
Kreuzer Dep. Ex. 59.	Document entitled "Interoffice Memo" from a Steve Kreuzer to a George Zehner and dated December 27, 1994 (1 page).



DEPOSITION EXHIBIT	IDENTIFICATION OF EXHIBIT
Kreuzer Dep. Ex. 60.	Document entitled "Interoffice Memo" from a Steve Kreuzer to a Don Sanders and dated February 3, 1995 (1 page).
Kreuzer Dep. Ex. 61.	Document entitled "Interoffice Memo" from a Steve Kreuzer to a George Zehner and dated March 7, 1995 (3 pages).
Kreuzer Dep. Ex. 62.	Document entitled "Interoffice Memo" from a George Zehner to a Don Sanders and dated March 3, 1995 (1 page).
Kreuzer Dep. Ex. 63.	Document entitled "Interoffice Memo" from a Steve Kreuzer to a George Zehner and dated March 20, 1995 (2 pages).
Kreuzer Dep. Ex. 64.	Document entitled "Interoffice Memo" from a Steve Kreuzer to a Tony Gallagher dated August 2, 1996 (2 pages).
Kreuzer Dep. Ex. 67.	Photograph of Uarco Press 391, as marked by Mr. Kreuzer during his deposition on September 8, 2003 (1 photo).
Kreuzer Dep. Ex. 68.	Document entitled "Interoffice Memo" from a Steve Kreuzer to a Van Kleinman dated November 2, 1995 (1 page).
Paulareno Dep. Ex. 127.	Same as Qunilan Dep. Ex. 127.

Appln No. 10/004,510  
Filed November 2, 2001

PATENT APPLICATION  
Attorney Docket 72412

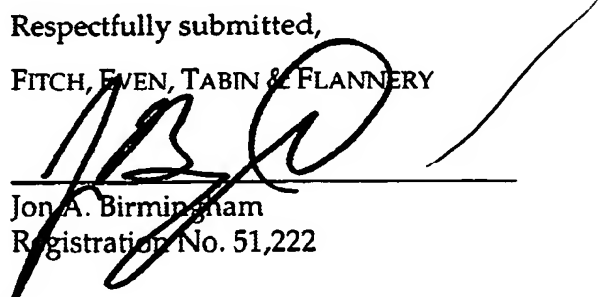
DEPOSITION EXHIBIT	IDENTIFICATION OF EXHIBIT
Paulareno Dep. Ex. 128.	Same as Qunilan Dep. Ex. 128.
Paulareno Dep. Ex. 129.	Same as Qunilan Dep. Ex. 129.
Paulareno Dep. Ex. 132.	Same as Qunilan Dep. Ex. 132.

The Applicant expressly files this Information Disclosure Statement pursuant to 37 C.F.R. §1.97(h), and therefore, the submission of this information is not to be construed as an admission that the information cited herein is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b).

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication or credit any overpayment to Deposit Account No. 06-1135.

Respectfully submitted,  
FITCH, EVEN, TABIN & FLANNERY

Date: January 6, 2004

  
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